

29. The method according to claim 28 wherein the area where the Bromus plants
grow is an area under cultivation.

out
A3

30. The method according to claim 28 wherein the Bromus plants are cultivated
selectively.--

REMARKS

This application provides for herbicidal compositions comprising at least one herbicidally active surfactants, at least one non-silicone surfactant and at least one humectant. Applicants discovered that the inventive compositions exhibit superior herbicidal activity, which may be synergistic in nature (see paragraph bridging pages 24 and 25).

This Amendment adds three claims in excess of 20 and a check for \$ 54.00 is enclosed to cover the cost of this fee. It is believed that no further fee is required for the consideration of this Amendment. If, however, an additional fee is required, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment to Deposit Account 50-0320.

This Amendment amends claims 1 and 4, cancels claims 5 to 11, without prejudice or the intention of creating estoppel, and adds claims 14 to 30. The recitation of specific classes humectants finds support on pages 23 and 24 of the specification. Cancelled claims 5 to 11 provide support for claims 14 to 24. Support for claims 25 to 27, which present some preferred embodiments, is found in the biological examples beginning on page 42 of the specification. Claims 28 to 30 find support in claims 7 and 9, which were rewritten in order to place them in compliance with conventional U.S. practice. Thus, no new matter is added by this Amendment. It is urged that as these amendments do not narrow the patent protection initially sought, the application of the doctrine of equivalents is not affected.

Applicants would like to bring copending application USSN 09/911,032 to the attention of the Examiner. The claims in that application also provide for herbicidal compositions which comprise, *inter alia*, humectants. That application is presently assigned to the same Examiner as this application.

Claims 6 and 9 to 11 stand rejected under 35 USC § 101 for being directed to non-statutory subject matter. In view of the new set of claims, which place the claims in conventional US format, it is urged that this rejection is moot and should be withdrawn.

Claims 1 to 13 stand rejected under 35 USC §103(a) for allegedly being unpatentable over the combined teachings of Griffin *et al.*, US 4,44,917 ("Griffin"), Zeneca, PCT WO 96/00010) and Matsumoto *et al.* ("Matsumoto"). Applicants respectfully disagree and urge the removal of the rejection as none of these publications taken in any fair combination suggests that the particular combination of active agents, non-silicone surfactants and humectants would provide herbicidal combinations that exhibit outstanding herbicidal activity, especially under dry conditions. In fact, it is urged that Matsumoto actually supports the patentability of the present claims it is known that the "incorporation of humectants sometimes had negative effect on the uptake" (p. 26), thereby suggesting that *a priori* it is impossible to predict the herbicidal activity of compositions comprising humectants. Therefore, reconsideration and withdrawal of his rejection are requested.

It is said that Griffen teaches that sulfonylurea herbicides "may be combined with combined with various surface active agents (column 6), as well as other adjuvants such as humectants (col 7, line 1) for herbicidal activity against various weeds, including *Bromus tectorum*." Office Action at 3. However, Griffen does not disclose specific humectants, let alone the specific humectants recited in claim 1. Similarly, Zeneca is said to disclose a combination of

glyphosate with an additional herbicidal agent, such as a sulfonylurea, humectant and a surfactant. *Id.* However, as with Griffen, this prior publication does not identify specific humectants. While the rejection states that Matsumoto teaches herbicidal compositions comprising a herbicide and a humectant, the compositions disclosed therein do not contain a surfactant.

From these teachings the rejection concludes:

it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined sulfonyl urea herbicides, surfactants, and humectants in a single herbicide combination because Griffin et al teach such combinations, and because the prior art teaches that surfactant and humectants are conventional additives in the herbicidal art.

Office Action at 3. Applicants respectfully disagree because none of these publications taken in any fair combination suggests that the particular combination of active agents, non-silicone surfactants and specific types of humectants would provide herbicidal combinations that exhibit outstanding herbicidal activity, especially under dry conditions. Moreover, in view of the uncertainty expressed in Matsumoto, it would be impossible to predict with any certainty that such a result would occur. Thus, at best, it would be merely obvious to try to add the humectants of Matsumoto to the composition taught by Griffen or Zenica. As obvious to try is not the standard under 35 USC 103(a), the rejection does not establish a *prima facie* case of obviousness.

Griffen and Zenica do not identify any specific humectants. These prior publications merely state that a humectant, among a laundry list of numerous other additives, may be added. The publications provide no suggestion to the practitioner that the addition of specific types of humectants to a herbicidal composition would produce compositions that exhibit superior herbicidal activity. It is urged that Matsumoto does not correct this deficiency

since it publication states on page 262 that “the incorporation of humectants sometimes had negative effects on the uptake.” More specifically, on page 267 Matsumoto states:

[t]he effect of humectants on herbicidal activity was examined for the urea herbicide and 2,4-D using glycerine and sodium lactate as humectants (Figure 9). In the case of glycerine, both herbicides showed higher activity with the case of no humectant. On the other hand, sodium lactate show almost the same, or rather low, activity compared with the no-humectant case.

On page 269, Matsumoto indicates that herbicidal activity is also adversely affected because of problems with solubility associated with the addition of some humectants. Hence, from Matsumoto, the practitioner would have no way of knowing *a priori* whether or not the addition of a humectant would improve or decrease the herbicidal activity of the composition. Thus, it is urged that at best the rejection indicated that it would be obvious to try to add a humectant; however, as noted above, obvious to try is not the standard of patentability under Section 103(a) of the Statute. Moreover, it is urged that the improved herbicidal effects exhibited by the inventive compositions would not be expected based upon these teachings (see biological data). For this reason, there is no motivation to add the humectant in the processes recited in claims 12 and 13.

Thus, in view of the foregoing, it is urged that the present invention is patentable over the combined teachings of Griffen, Zeneca and Matsumoto and reconsideration and withdrawal of this rejection are requested.

Favorable action is earnestly solicited.

Respectfully submitted,

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Appendix Showing Amendments to the Claims

1. (Amended) A herbicidal composition comprising
 - a) one or more herbicidal active substances,
 - b) one or more surfactants other than silicone surfactants, and
 - c) one or more humectants

wherein the humectant is selected from the group consisting of $MgSO_4$, polyhydric alcohols and their ethers and esters, polyalkylene glycols, ethylene oxide/propylene oxid copolymers, sugars, cellulose derivatives, citric acid, citric acid derivatives, lactic acid, lactic acid derivatives, tartaric acid, tartaric acid derivatives, aspartic acid, aspartic acid derivatives, succinates and polyvinyl compounds.

4. (Amended) A method of controlling harmful plants, wherein the herbicidal composition defined as in claim 1 is applied pre-emergence, post-emergence or pre-and post-emergence to the plants, plant parts, plant seeds or the area on which the plants grow, [for example the area under cultivation].